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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1224

GENERAL FOOTWEAR COMPANY LIMITED,

and

UNIVERSAL CITY STUDIOS, INC.,

Petitioners,

against

AMERICAN FOOTWEAR CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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Respondent American Footwear Corporation respectfully requests that this Court deny the petition for writ of certiorari, seeking review of the Second Circuit's opinion in this case. That opinion is now reported at 609 F.2d 655.

QUESTION PRESENTED FOR REVIEW

Petitioners' "question presented for review" is not merely partisan. The "question" is an argument grounded on "facts" not found in the record and contrary to the facts as found by the district court and accepted by the Second Circuit. Simply stated, the issue presented is:

Whether the descriptive non-trademark usage of a dictionary term in a television series gives the owner of the series the exclusive right to use that term as a trademark for footwear, so as to bring within the ambit of 15 U.S.C. §1125 the first user of the term as a trademark for footwear, in the absense of any predatory trading on the television series.

CORRECTED STATEMENT OF THE CASE

Again, in their "statement of the case", Petitioners have gone beyond partisanship to misstatement and mischaracterization. Inasmuch as sufficiently complete statements of the facts are contained in both the Second Circuit and the district court opinions reproduced

in the Appendix to the Petition (hereinafter referred to as "A "), it suffices here to note the following salient facts ignored by Petitioners, as found by the district court and as adopted by the Second Circuit:

a. The term "bionic" is a dictionary term meaning "[t]he science of designing instruments or systems modeled after living organisms", and is not a coined term. (A14, A30).

b. The term "bionic" was used descriptively by Universal, and not as a trademark. (A8-9, A31,33).

c. The licensing program of Universal's licensing agent, Merchandising, was a character endorsement program and not a program to license "bionic" as a trademark. (A7, A31,33). It should be noted that the titles of the television shows were "THE SIX MILLION DOLLAR MAN" and "THE BIONIC WOMAN".

d. American was the first entity to adopt the term "BIONIC" as a trademark for footwear and was the first entity to seek registration of that term as a trademark for footwear. American

adopted the trademark upon advice of counsel and applied for federal registration before any charge of infringement by Universal. (A6-7,17,A27-29,34).

e. American always clearly identified itself as the source of its boots. (A6, 8 (and n.2), A27-28, 30-31).

f. American made no effort of any kind to associate its boot with Universal's television series or to exploit the reputation and good will engendered by the television series. (A8, 13, A30-31, 33). The "running girl" poster, the sole evidence relied upon by Petitioners to the contrary, was dismissed by the Second Circuit as follows:

> conceding that American's "Bionic Boots" were not designed to be the functional equivalent of track shoes, an advertisement for footwear does lend itself to a running pose. Moreover, the similarities between the poster and the scenes from the TV shows are not so marked that, when the poster is displayed together with numerous and prominent references to American and to no other entity, an ordinarily prudent purchaser would be likely to be misled into believing that any sponsorship arrangement existed between Universal's TV shows and American's product.

(A8 at n.2). The district court was so unimpressed with this "evidence" that it found it unworthy of mention despite the stress placed thereon in Petitioners' briefs.

g. There is no likelihood that the public would confuse American's BIONIC boot as emanating from or having connection with any of Petitioners. (A4, A33).

REASONS WHY THE WRIT SHOULD BE DENIED

1. This Case Was Decided On Its Facts And Presents No Important Issues

Petitioners attempt to aggrandize this case out of proportion to reality in an attempt to come within Rule 19 of this Court. A consideration of the Second Circuit opinion reveals that this case was decided on its facts and not on the lofty principles enunciated by Petitioners. Petitioners' claims were not defeated by reason of the Second Circuit's application of the standard

for "likelihood of confusion".

Rather, Petitioners' trademark claims were defeated by reason of their failure to prove that either Universal's descriptive, non-trademark use of the dictionary term "bionic" or Merchandising's program of licensing the THE SIX MILLION DOLLAR MAN and THE BIONIC WOMAN characters created a property right in the term "bionic" per se for footwear, no less for all goods. A trademark right is not "a right in gross or at large like a statutory copyright or a patent for an invention" and "[t]here is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed." United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918). While Petitioners' claim to trademark rights in gross in "bionic" must fall as a matter of law, in fact it never gets off the ground by reason of Petitioners' failure to prove the existence of any trademark right in "bionic" per se.

Petitioners' unfair competition claims were likewise defeated on the

facts, and not the law. Petitioners failed to prove any act of unfair competition by American. Unlike the defendants in the cases relied upon by Petitioners, American made no effort of any kind to associate its boot with Universal's television shows or with any of the characters in those shows. Rather, American, at all times, made it clear that its BIONIC boot was an American product.

The opinion of the Second Circuit in no way interferes with the licensing of legitimate "properties" generated by the television and movie industries. Prove a property right or predatory conduct by the defendant and the Second Circuit will provide a remedy. Fail to prove either, as Petitioners did here, and you are no more likely to gain relief in Texas then in New York.

2. There Is No Conflict Between The Second and Fifth Circuits

In an alternative attempt to come within Rule 19 of this Court, Petitioners attempt to create a conflict between the Second and Fifth Circuits where none exists.

Petitioners rely on Boston Professional Hockey Assoc., Inc. v. Dallas Cap & Emblem Mfg., Inc., 510 F.2d 1004 (5th Cir. 1975), cert. denied, 423 U.S. 868. In the Boston case, the defendant copied the uncopyrighted team symbols of plaintiff professional hockey teams after being denied a license and sold the team symbols as embroidered cloth emblems. The Fifth Circuit faced a difficult conceptual problem in that plaintiffs' trademarks were being sold by defendant, the dominant feature of the emblems (the "goods") being the trademarks. The court grounded its decision on three factual determina- tions not present in the instant case. Id. at 1011. The court's analysis of the secondary meaning requirement under 15 U.S.C. §1114 (infringement of a federally registered trademark - a section not at issue in this petition), did not reject "source of origin" as a focal point of confusion, but rather, found a likelihood of confusion in the sale of trademark symbols by a defendant who knew that the buyer would conclude that the source and origin of the trademark symbols were

plaintiffs. In other words, the likelihood of confusion was grounded on a finding of an intent to confuse.

The Boston case is distinguishable from the instant case on its facts. In Boston the defendant sought a license from plaintiffs, appropriated established trademarks and used such trademarks in a manner intended to associate its emblems with plaintiffs' teams and to exploit the reputation and good will engendered by such teams. Id. at 1011-1012. In the instant case, Respondent made no request for a license, appropriated no trademark of Petitioners and, as found by the courts below, made no effort to associate its boot with Universal's television series or to exploit the reputation and good will engendered by the television series. (A8). Having found no indicia of predatory conduct sufficient to satisfy the likelihood of confusion test (A13), the Second Circuit turned to the main branch of the test for likelihood of confusion, "the likelihood that the consuming public will be confused as to the source of the

allegedly infringing product", and found no such likelihood. (A16).

The Second Circuit would have granted a remedy to the plaintiffs in the Boston case, given the proof of predatory conduct by the defendants. Cf. Flexitized, Inc. v. National Flexitized Corp., 335 F.2d 774 (2d Cir. 1964), cert. denied, 380 U.S. 913 (1965); National Lampoon, Inc. v. American Broadcasting Co., 376 F.Supp. 733 (S.D.N.Y. 1974), aff'd, 497 F.2d 1343 (2d Cir. 1974) (per curiam). On the other hand, given the facts in this case, Petitioners could not have prevailed in any circuit. Cf. HMH Publishing Co. v. Brincat, 504 F.2d 713, 718-20 (9th Cir. 1974) (preliminary finding of no likelihood of confusion, based on the descriptive nature of the trademark and the remoteness of the respective products of the parties, overcome by presence of predatory conduct).

D C Comics, Inc.v. Powers, 465 F. Supp. 843 (S.D.N.Y. 1978), also relied upon by Petitioners, is likewise distinguishable on its facts. In D C Comics the court found predatory conduct

by defendants - the contents and promotion of defendants' newspaper was built thematically around plaintiff's Superman character. In the instant case, "there was no proof that American's advertising was built thematically around Universal's television shows ...." (A13). D C Comics merely demonstrates that had Petitioners proved either predatory conduct or pertinent trademark rights, they would have been granted a remedy by the Second Circuit.

Accordingly, there is no conflict between the Second and Fifth Circuits in connection with the "likelihood of confusion" test, nor did the Second Circuit err in applying that test in this case.

CONCLUSION

The decision of the Second Circuit denying Petitioners' claims under 15 U.S.C. §1125 is manifestly correct. No conflict between the circuits has been demonstrated. No important question of federal law unsettled by this Court has been presented. Accordingly, it is respectfully submitted that the petition

for certiorari should be denied.

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